

Remarks

1. The Examiner has rejected claims 1 to 3, 10 to 12 and 15 to 17 under 35 U.S.C. §102(b) as being anticipated by Pinter (US5894506). Applicant has therefore amended the term “associated with said user” to replace it by the term “specific to said user” (emphasis added) at all occurrences throughout the claims as currently pending in this application. This amendment clarifies that the pre-specified message that is stored at the messaging server and that is to be sent from the messaging server to a destination party mail box in response to a user input is a message that is specific to that user and, by inference, not specific to other users. The pre-specified message is made specific to the user by virtue of the fact that the user creates the message for storage on the messaging server by way of pre-recording the message at the user's mail box. Basis for this amendment is found at page 2, lines 19 to 21.

2. In contrast, although the “canned” messages of Pinter might be argued to be associated with said user, they are not “specific to said user” as required, for example, by claim 1 of the present application. In Pinter, a first file of canned messages is maintained at a network operation center and a second file of canned messages corresponding to the first file is maintained at a terminal of a calling subscriber (column 1, lines 54 to 59). The canned messages can be customized, either by the network operations center or from a subscriber terminal according to the needs of a particular group or organization of subscribers (column 2, lines 1 to 6). Thus, it can be seen that Pinter does not disclose the feature of the pre-specified message being specific to the user as required by claim 1 as amended. Claim 1 is therefore not anticipated by Pinter. The same reasoning applies to other independent claims as submitted herewith.

3. Pinter also does not teach the feature of claim 1 of sending the pre-specified message to a destination party mail box. In Pinter, when a terminal receives a canned message/response option transmission from the network operations center,

the terminal determines whether the canned message/response option is in message text or canned message code. If in text, the canned message and any response options are displayed to the receiving party. If in code, the terminal retrieves the associated canned message etc. from corresponding stored canned message files at said (receiving) terminal. There is no suggestion in Pinter that the text of the canned message or a code indicative thereof is sent to a destination party mail box. Consequently, Pinter does not teach all the features of claim 1 of the present application as submitted herewith. Similar reasoning applies to other independent claims as submitted herewith.

4. The Examiner may be tempted to argue that the present invention as defined by claim 1 would have been obvious in view of Pinter, either on its own or in combination with Baxter (US6385305). The Examiner will be aware that in *ex parte* examination of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent and Trademark Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531

(Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

5 In Pinter, a canned message is a message that is not specific to any particular user, but is a message that is applicable to a group or organization of users. In Pinter, a user can select by means of a code a canned message stored in his/her subscriber terminal from a file of such messages and arrange for this message to be sent to a receiving terminal. In Pinter, when a terminal receives a canned message/response option transmission from the network operations center, the terminal determines whether the canned message/response option is in message text or canned message code. If in text, the canned message and any response options are displayed to the receiving party. If in code, the terminal retrieves the associated canned message etc. from corresponding stored canned message files at said (receiving) terminal. Thus, Pinter addresses the problem of bandwidth considerations by storing at each of the sending terminal, network operations centre and receiving terminal corresponding files of canned messages and transmitting codes indicative of such stored corresponding canned messages. A user at a sending terminal can therefore send a canned message to a user at a receiving terminal by relaying only a code for said canned message to said receiving terminal via said network operations centre. It follows from this therefore that the canned messages must be of forms that are generally applicable to any user (of a group or organization) and cannot be specific to a particular user. Consequently, Pinter teaches against the present invention which enables a user to send a pre-specified

message specific to the user (sender) to a destination party mail box. This is advantageous in that the user (sender) can tailor such messages specifically for the recipient rather than using the formulaic approach of the canned messages of Pinter. A further advantage offered by the present invention is that there is no need to store any pre-specified messages at either of the sending subscriber or receiving subscriber terminals as is required by Pinter. This is particularly advantageous for handheld wireless devices or the like where memory capacity is limited. Similar reasoning applies to all the independent claims. Consequently, the present invention as defined by these claims is not rendered obvious by the disclosure of Pinter.

6. There is nothing in the disclosure of Baxter that would enable or even motivate one skilled in the art to modify the system of Pinter to arrive at that of the present invention.

7. In view of the fact that all the Examiner's rejections relating to the currently pending claims have been fully addressed, further and favourable consideration of these claims is respectfully requested.

8. New claims 20 to 31 have been added. These claims are directed to an embodiment of the present invention in which a user can append spoken information to a pre-specified message prior to it being sent to a destination party mail box. Basis for these claims is particular found at page 10, lines 14 to 29 of the specification.

9. It is noted that Baxter teaches the additional step of encoding a sponsor message into an electronic message where the encoding comprises appending a digital audio file with an audio sponsor message or encoding a text based sponsor message into the body of the electronic message etc. However, one skilled in the art would not seriously contemplate modifying the system of Pinter with that of Baxter to

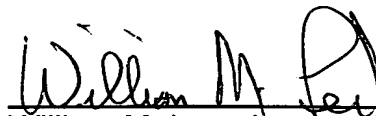
arrive at the present invention as defined, for example, by new claim 20. A principal objective of the system of Pinter is to provide an improved electronic messaging network wherein communications links capacity is conserved by transmitting messages with an improved degree of compression (column 1, lines 37 to 41). This is achieved by storing at each of sending terminals, receiving terminals and a network operations center corresponding copies of canned messages. A canned message can then be sent from a sending terminal to a receiving terminal by sending from the sending terminal only a code indicative of said canned message. At the receiving terminal, said terminal uses the code to retrieve the canned message from its local store of canned messages. Thus, the system of Pinter enables compression of messages through the transmission of codes indicative of said messages. Pinter does also enable some digital parameters to be added to a selected canned message but these are of digital form and short in length, i.e. low bandwidth. However, Pinter makes no suggestion that anything other than simple digital parameters can be added to a canned message and it would go against the teaching of this reference to add to the canned message, or more pertinently, the code indicative of said message high bandwidth spoken information from a user. Consequently, one skilled in the art would not seriously contemplate modifying the system of Pinter in view of that of Baxter since to do so would contravene the principal objective of Pinter.

10. Favorable consideration of new claims 20 to 31 is also respectfully requested, and the appropriate additional fees are tendered herewith.

11. An appropriate Petition for Extension of Time is also submitted herewith.

November 11, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William M. Lee, Jr.", is written over a horizontal line.

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